

terminology "immediate" is not literally supported in this specification, it is felt inherent and thus not "new matter". Grounds for the §112 rejection do not exist. Withdrawal of the rejection is requested.

While the examiner's §112 rejection was limited to claim 1 and its dependencies, applicants believe the rationale therefor is applicable to claims 11 and 21 and their dependencies. Hence, amendments corresponding to those made in claim 1 are introduced *sua sponte* into claims 11 and 21.

Further, in the interest of improving the clarity of the specification, amendments thereto were also made.

#### ***Claim Rejections – 35 USC § 103***

Claims 1, 3-6, 8-11, 13-16, 18-21, and 23-26 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Craven et al. (U.S. Patent 5,157,424) in view of Merry et al. (U.S. Patent 5,178,418).

Applicants essentially claim a document having corresponding first and second printed matter representative of individual-specific information, the document being particularly characterized in the location, scale, and color of its second printed matter. In particular, the scale of the second printed matter is "significantly smaller" than the scale of the first printed matter. Further, the location of the second printed matter (*i.e.*, the "second location") is "spaced" from the location of the first printed matter. And, the color of the second printed matter is "selected to effect minimal contrast between said second printed matter ... and its immediate background".

Applicants have reviewed the cited art references and have considered objectively the examiner's comments. Applicants, however, do not agree with the examiner's conclusions. The invention defined in the claims as amended is not foreshadowed by the cited art references.

The Craven reference discloses a method and apparatus for manufacturing tamper-resistant identification cards containing a first signature at a first location and a duplicate digitized signature superimposed over a digitized image (photograph) at a second location. Both signatures are identical in size and provide an inspecting authority to readily, *i.e.*, without magnification determine whether the tampered duplicate signature on the photograph is the same as the operator's untampered signature, the one that properly belongs to the document. In the use of Craven's identification card, it is important that both signatures be

perceptible without magnification. Further, while Craven discloses printed matter having a color contrasting with the background of the document, and may permit a reduced size of the duplicate signature, there is no suggestion or teaching by Craven to minimize the contrast to render the second printed matter much less perceptible to an unassisted eye. In fact, Craven strives to reveal both signatures to enable one to readily detect tampering of the photograph, i.e., the tampered signature as well, which has been superimposed on the photograph.

The Merry reference, on the other hand, is a security device containing reduced size alphanumeric characters, which when ordinarily viewed appear uniform but with the aid of a magnification means provide a latent image due to the phase shifting of the characters, the latent image being indiscernible to the naked eye.

While Merry discloses magnification means of hidden alphanumeric text to reveal a latent image, the method is not suitable to produce individual cards that provide identifying information. Furthermore, there is no suggestion or teaching in Merry to provide duplicate identifying information which is only revealed with magnification. In contrast, Merry provides groups of characters which are phase shifted to reveal a latent hidden image upon magnification.

Applicants respectfully submit that there is no suggestion or teaching in the references that would lead one of ordinary skill in the art toward applicants' invention. To the contrary, the Craven reference teaches away from the invention by providing a second printed matter which is readily viewable without magnification and is intended to be visible. Likewise, the Merry reference teaches away from the invention by providing microprint which covers the entire document and is concealed unless viewed with magnification. Merry does not have a concealed duplicate identifying information which provides authentication for security documents.

Examiner's contention that the contrast provided by the Craven reference is the same as the contrast provided by the invention is incorrect because the purpose of the contrast in Craven is to reveal while that of the invention is to conceal. Applicants disagree with Examiner's view that "matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability". The *contrast* is not a mere choice of ornamentation having no mechanical effect or advantage, but rather, provides an important, and patentably distinct

feature of the invention, i.e., to minimize the contrast such as to render less perceptible the duplicate identifying information.

Another major difference between the subject matter of the Craven reference and applicants' invention is that the second printed matter -- which is a mere duplicate of the signature at a second location -- of Craven is visible and provides a means of detection of tampering unlike the second printed matter of the invention which is concealed to thwart counterfeiters to reproduce the card. The security feature of the duplicate signature in Craven is visible and aids to detect tampering of the identification card, whereas the security feature of the second printed matter in the Applicants' invention is concealed to thwart replication of the identification document.

The disclosure of microprinting in the Merry reference has no bearing on the claimed invention, because Merry teaches away from using identifying information by describing the preferred methods of printing the character array to be "intaglio and offset lithography" (col.3 line 38). The methods suitable to produce applicants' invention for conveying identifying information renders the cited art (*i.e.*, Merry) unsatisfactory for its intended purpose (*i.e.*, latent images comprising phase shifted micro printing). Examiner's contentions of obviousness based on the Merry and Craven references change the principle of operation of the references themselves.

In light of the above, applicants do not believe that invention defined in independent claim 1 is obvious, and accordingly, request withdrawal of the examiner's rejection. Claims 3 to 6 and 8 to 10 are dependent on claim 1. Withdrawal of the rejection of these claims is also requested.

While applicants have confined their arguments to independent claim 1, the arguments are equally applicable to independent claims 11 and 21. Both claims have been amended to conform with the amendments to claim 1. Withdrawal of the rejection of claims 11 and 21, and their dependencies, is requested.

*Conclusion*

The pending claims distinguish over prior art. The claims are in proper form. The application is believed to be in condition for allowance.

Respectfully submitted,

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